

REMARKS

Reconsideration and allowance of the above identified patent application are hereby requested. Claims 1-18 are now in the application with claims 1 and 18 being independent. Claims 1, 3-5, and 18 have been amended. No new matter has been added. The Office's rejections are respectfully traversed.

Rejection Under 35 U.S.C. §103

Claims 1-2, 4-6, 8-10, 13-14, and 16-18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,222,909 to Qua et al. in view of U.S. Patent Application Publication No. 2001/0034225 to Gupte et al. Further, claim 3 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Qua et al. and Gupte et al. in further view of U.S. Patent No. 6,205,342 to Oakes et al. Claims 7 and 11-12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Qua et al. and Gupte et al. in further view of U.S. Patent Application Publication No. 2002/0016174 to Gibson et al. Additionally, claim 15 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Qua et al. and Gupte et al. in further view of U.S. Patent No. 6,212,550 to Segur. The Office's contentions are respectfully traversed.

As amended, claim 1 recites (underlining added for emphasis) "...communicatively connecting to a first server over the wireless communications network; receiving input from the user selecting an option presented by the first server to send the audio file to the email recipient; communicatively connecting the wireless communication device to a second server over the

wireless communications network in response to the selected option, wherein the first server transmits a signal to the second server indicating a pending connection with the wireless communication device; recording the audio file on the second server; and sending the recorded audio file to the email recipient.”

Qua et al. do not disclose receiving input from the user selecting an option presented by the first server to send the audio file to the email recipient and communicatively connecting the wireless communication device to a second server over the wireless communications network in response to the selected option.

The Office (Action of March 21, 2007 at page 6) asserts that Qua et al. teach “Selecting an option to send the audio file to the email recipient, (column 5, lines 46-52 and column 3, lines 59-66);....” Qua et al. fail to disclose the claimed subject matter.

Qua et al. (Col. 5, lines 46-52 and Col. 3, lines 59-66) disclose that, once the audio note has been recorded, it can be distributed via an electronic mail server. However, Qua et al. do not disclose communicatively connecting the wireless communication device to a second server, such as an email server, over the wireless communications network in response to the selected option. To the contrary, Qua et al. disclose (Col. 5, lines 52-57) that a wireless terminal connects to the audio note taking mechanism, which controls the audio note taking and audio note distribution functions (underlining added for emphasis):

In both instances, audio note taking mechanism 129 can either forward the actual file as an attachment or a pointer indicating the location of the file. If forwarding is accomplished using the e-mail server, audio note taking mechanism 129 determines if the file should be compressed prior to distribution (step 312).

Thus, Qua et al. do not disclose, teach, or suggest receiving input from the user selecting an option presented by the first server to send the audio file to the email recipient and communicatively connecting the wireless communication device to a second server over the wireless communications network in response to the selected option, as is claimed.

Gupte et al. also fail to disclose communicatively connecting the wireless communication device to a second server over the wireless communications network. Rather, Gupte et al. (para. 0014) disclose that a selected electronic communication is provided to a wireless communication device in response to a single action. Gupte et al. (para. 0021) further disclose (underlining added for emphasis) “Accordingly, the user can immediately and directly access one specific email by pressing only one key....” Thus, Gupte et al. disclose that a wireless communication device connects to a single server to access a single message. Therefore, Gupte et al. also do not disclose, teach, or suggest communicatively connecting the wireless communication device to a second server over the wireless communications network in response to the selected option, as is claimed.

Further, Qua et al. do not disclose that the first server transmits a signal to the second server indicating a pending connection with the wireless communication device. With respect to claim 5, the Office (Action of March 21, 2007 at page 10) asserts that...

Qua and Gupte show the audio note taking method wherein the step of communicatively connecting to a second server (i.e. adjunct server for audio note taking mechanism) further comprises: transmitting a signal to the second server indicating a pending connection with the wireless communication device (Qua column 3, lines 8-13 and column 3, lines 22-26);

Qua et al. and Gupte et al., taken alone or in combination, fail to disclose the claimed subject matter.

With respect to transmitted signals, Qua et al. (Col. 3, lines 8-13) disclose (underlining added for emphasis)...

In an exemplary embodiment of the present invention, an audio note taking mechanism 129 is implemented within network components 135 and/or an adjunct server 130 and is responsive to user input processing and control signal generation from wireless terminal 110 and/or wireless terminal 150.

Similarly, Qua et al. (Col. 3, lines 22-26) disclose (underlining added for emphasis):

In general, a user can take multiple audio notes of a specific conversation by starting and stopping a recording device included in audio note taking mechanism 129 by generating appropriate control signals from a respective communication device during that conversation.

Qua et al. (Abstract) further indicate that a wireless or wired communication device is employed by a user to carry out a conversation. As such, a communication device is not equivalent to a server. Thus, the cited portions of Qua et al. disclose only that a server is responsive to signal generation from a communication device, such as a wireless terminal. Therefore, Qua et al. fail to disclose, teach, or suggest communicatively connecting the wireless communication device to a second server over the wireless communications network in response to the selected option, wherein the first server transmits a signal to the second server indicating a pending connection with the wireless communication device, as is claimed.

Gupte et al. also fail to disclose, teach, or suggest that the first server transmits a signal to the second server indicating a pending connection with the wireless communication device.

Rather, Gupte et al. (para. 0017) disclose that a wireless communication device accesses a single server to retrieve a single message (underlining added for emphasis):

At least a portion of the protocol scheme in the notice has information that allows the cell phone 12 to automatically access the server system 18 with only a single action by the user, such as by pressing one key 22 on the phone's keypad 24. This single action by the user will provide the user with access to that one specific email message, so the user can receive or act on that message.

Thus, Gupte et al. teach that the communication device of a user accesses only one server.

Therefore, Gupte et al. also fail to disclose that the first server transmits a signal to the second server indicating a pending connection with the wireless communication device, as is claimed.

Additionally, the Office (Action of March 21, 2007 at page 6) asserts that Qua et al. teach (underlining added for emphasis) “recording the audio file on the second server (column 3, lines 22-26; column 4, lines 19-25; and column 4, lines 40-43);....” The Office (*Id.*) also asserts (underlining added for emphasis) “Communicatively connecting to a second server (i.e. email server)....” Thus, the Office asserts that the second server is the email server disclosed by Qua. As such, in accordance with the Office’s assertion, Qua et al. must teach recording the audio file on the email server. Qua et al., however, fail to disclose such subject matter.

Rather, Qua et al. (Col. 3, lines 39-41) disclose that the audio note taking function is performed independent of an email server (underlining added for emphasis):

In an exemplary embodiment of the present invention, an audio note taking mechanism 129 is implemented within network components 135 and/or an adjunct server 130 and is responsive to user input processing and control signal generation from wireless terminal 110 and/or wireless terminal 150.

Further, Qua et al. (Col. 4, lines 22-25) disclose ‘Note that the working memory can be located anywhere in network components 135, wireless terminal 110, adjunct 130, associated storage 180 or even in detachable storage unit 120.’ Thus, Qua et al. also do not disclose recording or storing an audio file on an email server.

Qua et al. (Fig. 1) do, however, disclose a separate email system 160. Further, Qua et al. (Col. 5, lines 46-52) disclose transmitting a recorded audio file using an electronic mail server (underlining added for emphasis):

Referring now to FIG. 3, audio note taking mechanism 129 determines if the audio note is to be processed as an audio file or as a text file (step 305). If the audio note is processed as an audio file, audio note taking mechanism 129 then determines whether the user has selected to forward the message via an electronic mail server or a voice mail server (step 310).

Thus, Qua et al. teach that the audio note taking mechanism is separate from an email server. Therefore, in accordance with the Office’s interpretation, Qua et al. also do not disclose recording the audio file on the second server, as is claimed.

Moreover, the Office (Action of March 21, 2007 at page 7) asserts that (underlining added for emphasis)...

Qua discloses “numerous modifications and alternative embodiments of the invention would be apparent to those skilled in the art...without departing from the spirit of the invention.” (column 8, lines 14-22). Therefore, it would have been obvious for one of ordinary skill in the art at the time of invention to modify the sequence of the method disclosed by Qua, so as to first connect to an email server, as further evidenced by Gupte.

There is insufficient motivation to modify Qua et al. based on the teachings of Gupte et al. as the Office suggests. MPEP §2143.01 states (underlining added for emphasis) “If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

Qua et al. (Abstract) is directed to (underlining added for emphasis) “An audio note taking system and method that permit a user to record audio information during a conversation on a wireless or wired communications device and distribute the information to other users....” Further, Qua et al. (Col. 4, lines 11-15) disclose that one or more audio notes can be taken (underlining added for emphasis) “Once a call has been established between the user and a destination party or parties,...” Additionally, Qua et al. (Col. 3, line 52 to Col. 4, line 3) disclose that an audio note, once recorded, can be designated for further processing in a variety of ways, only one of which entails forwarding through email.

Modifying the method disclosed by Qua et al. to first connect to an email server would render the system inoperable for its intended purpose of recording audio notes during a conversation. The modification would prohibit a user from recording an audio note once a call has been established until the user also had connected to the email server. Moreover, there is no suggestion in Qua et al. or Gupte et al. that such a connection is technically possible. Further, the proposed modification would render inoperable a number of additional processing options disclosed by Qua et al., such as forwarding an audio note via voice mail (Col. 3, lines 61-66) and the intermingling of comments with the actual conversation to create an annotated recorded

message (Col. 4, line 63 to Col. 5, line 3). Therefore, there is insufficient motivation for the proposed modification of Qua et al. based on the teachings of Gupte et al.

Additionally, as discussed above, the proposed modification based on Gupte et al. would change the principle of operation of Qua et al. For example, a user would no longer be able to initiate recording of an audio note when a call between parties has been established. Instead, the user would be required to have first connected to an email server. Thus, in accordance with MPEP §2143.01, the teachings of Qua et al. and Gupte et al. also are not sufficient to render the claimed subject matter *prima facie* obvious.

For at least these reasons, amended claim 1 is allowable over the proposed combination of Qua et al. and Gupte et al. Claims 2-17 depend from claim 1 and are therefore allowable for at least the reasons discussed with respect to claim 1.

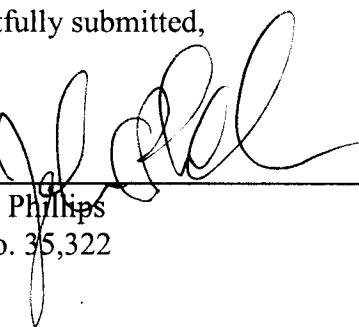
Further, claim 18 includes subject matter similar to that of claim 1. Therefore, claim 18 is allowable for at least the reasons discussed with respect to claim 1.

Concluding Comments

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

In view of the above remarks, claims 1-18 are in condition for allowance, and a formal notice of allowance is respectfully requested. Please apply the fee of \$120 for a one-month extension of time and any other applicable charges or credits to deposit account 06-1050.

Respectfully submitted,



John C. Phillips
Reg. No. 35,322

Date: July 23, 2007

Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099